



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/807,652	02/27/97	MAJEED	P8064-6032

12M2/1212
METROPOLITAN SQUARE
SUITE 330 G STREET LOBBY
655 15TH STREET NW
WASHINGTON DC 20005-5701

EXAMINER
GOLDBERG, J

ART UNIT	PAPER NUMBER
1205	17

DATE MAILED: 12/12/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action SummaryApplication No.
08/807,652Applicant(s)
MajeedExaminer
Jerome D. GoldbergGroup Art Unit
1205☒ Responsive to communication(s) filed on Nov 10, 1997☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims☒ Claim(s) 1-25 is/are pending in the application.Of the above, claim(s) 5-9, 14-18, and 25 is/are withdrawn from consideration.☐ Claim(s) is/are allowed.☒ Claim(s) 1-4, 10-13, and 19-24 is/are rejected.☐ Claim(s) is/are objected to.☐ Claims are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on is/are objected to by the Examiner.☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial Number: 08/807,652

Page 2

Art Unit: 1205

The restriction requirement is herein being modified in that claims 5-9 drawn to treating mood disorder are being examined with the Group II inventions.

Claims 5-9, 14-18 and 25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 6.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Serial Number: 08/807,652

Page 3

Art Unit: 1205

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 10-13 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wachtel et al. reference.

The Wachtel et al. reference teaches applicants' compound as a pharmaceutical being administered up to 25 mg/kg (see table 1, page 431, column 2). In view of this, the claimed composition would be motivated, ~~With~~

Serial Number: 08/807,652

Page 4

Art Unit: 1205

regard to the method claims 1-4, the forskokin to a normal host as set forth in the prior art would be including in these claims.

Claims 10-13 and 20-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 10-13 and 20-23 are improperly drawn to the same composition. Correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. D. Goldberg, whose telephone number is (703) 308-4606. The examiner can normally be reached on Monday-Thursday from 9:00 a.m. to 3:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Cintinis, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-4556.

Serial Number: 08/807,652

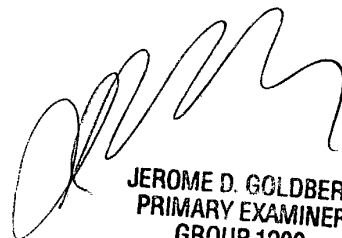
Page 5

Art Unit: 1205

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

J. D. Goldberg:cb
Patent Examiner

Wednesday, November 26, 1997



JEROME D. GOLDBERG
PRIMARY EXAMINER
GROUP 1200